## REMARKS/ARGUMENTS

The Office Action mailed October 5, 2004, has been received and reviewed. Claims 1 through 35 are currently pending in the application. Claims 1 through 35 stand rejected. Applicants have amended claims 2, 21, 24-26, 28 and 31, and claims 1, 12-20, 27, 30 and 32-35 have been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration of the application as amended herein.

**Objection to the Drawings**

The present Office Action states that the drawings filed on June 1, 2001, are objected to by the Examiner. Applicants note that new drawings were submitted on October 30, 2001, as part of a Reply to Notice of Incomplete Reply. If the new drawings are not considered to overcome the present objection, it is further noted that no discussion of the basis for objecting to the drawings was set forth in the present Office Action. Therefore, Applicants request that the present objection be withdrawn, or that the basis for the objection be provided so that Applicants may have an opportunity to respond accordingly.

**35 U.S.C. § 102(b) Anticipation Rejections**

Anticipation Rejection Based on International Patent Publication No. WO 00/22543 to Hong

Claims 1-3, 12, 27, 29, 30 and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hong (WO 00/22543). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Turning to the cited reference, Hong is directed to a method and system for interrogating the Internet to identify a server to which a user at a remote location belongs. A system embodied by Hong is described as including a remote access mail client 1 that, in conjunction with a dynamic access database 2, allows a user at a remote computer 6 to identify and contact an electronic mail server 8 storing the user's e-mail (pp. 6-7). The client 1 also has Internet access to the DNS database 3, the WHOIS server 4 and the POP3/IMAP4 search engine 5 (Figure 1).

According to the method described in Hong, a user first logs into an ISP at computer 6 and then accesses client 1 via a browser 7 (pp. 7-8). The user enters their electronic mail address and log-in password, and client 1 initiates a sequence of actions to identify the user's server from the information provided. In a first stage of a first phase, client 1 parses the electronic mail address to obtain a presumed domain name by stripping out the user identity (p. 8). Client 1 then interrogates access database 2 to determine whether there is a user record indicating the user's server (Figure 2, Table T1) or a domain record that corresponds to the presumed domain name (Figure 2, Table T2). If there is such a record, the user's details are sent to the identified server to retrieve the user's mail (p. 8).

In a second stage of the first phase, client 1 assumes that the domain name is the user's server and checks the domain for the user's mail (p. 9). If there is a negative response from the domain name, client 1 sends out a DNS inquiry to check for the MX record. Each response from DNS database 3 is checked to see if ports associated with the POP3 or IMAP4 protocol are open or closed, and the user's information is sent to any response having an open port to retrieve the user's mail.

If the first phase of the method fails to identify the user's server, client 1 initiates a first stage of a second phase of the method by obtaining the IP address of the MX record and checking to see if the mail protocol ports associated with IP addresses 2-254 are open or closed (p. 9). All IP addresses with open ports are subsequently checked for the user's mail. If the enumeration of IP addresses fails to identify the user's server, client 1 initiates a second stage of the second phase, in which the entire list of names CANME and/or HOST is requested for the presumed domain name by zone transfer from the DNS database 3 (p. 10). Again, the host names are

checked for open port status, and the host names having an open port are checked for the user's mail.

If the second phase fails to identify the user's server, client 1 initiates a third and final phase by retrieving from the WHOIS server the IP address block which has been allocated to the domain organization or company and scanning the addresses in the block for open ports (p. 10). All addresses having open port status are used to check for the user's mail.

Applicants respectfully submit that the above-described system and method of Hong fail to disclose, either expressly or inherently, all of the elements recited in claims 2-3, and 29.

Claim 2 is amended herein into independent form to include the limitations previously recited in claim 1. Claim 29 depends from claim 28, which is amended herein into independent form to include the limitations previously recited in claim 27. Claim 2 recites the limitation "wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in *a list of closed domains that do not include server computers employing the electronic mail protocol.*" (Emphasis added.) Claim 28 recites the limitation "wherein the server mapper is configured to compare the domain with *a list of closed domains that do not include server computers employing the electronic mail protocol.*" (Emphasis added.)

Hong fails to disclose the concept of consulting a list of closed domains that do not include server computers employing the electronic mail protocol, as recited in the context of the present claims. In the instant rejection, the Office asserts Hong teaches this limitation at page 2, ¶ 4 and page 10, ¶ 3, when describing the storage of accessed domains for future reference in the access database 2 (Office Action, p. 3). Applicants respectfully submit that the Office has mischaracterized the disclosure of Hong. As discussed above, Hong describes checking IP addresses for open mail ports, and then checking those locations for a user's mail. Hong indicates that, based on this query, "a record of any successful response is written into the access database 2." (p. 9, ¶ 3). (See also, p. 9, ¶ 4 and p. 10, ¶¶'s 1-2: "host names having open port status are written into the access database 2"; "a record of any successful host being written into the access database 2.") Accordingly, Hong merely teaches storing a list of names having open

ports in access database 2, and does not describe a list of closed domains as recited in the context of the present claims.

In view of the foregoing, Applicants respectfully submit that Hong fails to disclose all of the elements of claims 2 and 28, and claims 2 and 28 are allowable under the provisions of 35 U.S.C. § 102(b). Claims 3 and 29, which respectively depend from and incorporate the limitations of claims 2 and 28, are also allowable. The rejections of claims 1, 12, 27, 30 and 35 are moot, as these claims have been cancelled without prejudice or disclaimer.

**35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on International Patent Publication No. WO 00/22543 to Hong in View of "Official Notice"

Claims 4-11, 13-26, 28 and 31-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of official notice taken by the Examiner. Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant=s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 4-11, 13-26, 28 and 31-34 are improper because they fail to establish a *prima facie* case of obviousness.

Claims 4-11 and 24-26 depend from amended claim 2. Claim 2 recites the limitation "wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in *a list of closed domains that do not include server computers employing the electronic mail protocol.*"

(Emphasis added.) Claim 28, as amended, recites the limitation "wherein the server mapper is configured to compare the domain with *a list of closed domains that do not include server computers employing the electronic mail protocol.*" (Emphasis added.) As previously discussed above, Hong fails to disclose these limitations.

In setting forth the basis for the present rejections, the Office acknowledges that Hong does not teach saving a list of closed domains (Office Action, p. 6). The Office asserts, however, that it would be obvious (based on Hong at p. 10, ¶ 3) to also store a list of closed domains so the system does not have to go through the process of verifying all the closed domains in the future to save time and increase efficiency by allowing the user faster access. Applicants respectfully submit that there would be no motivation for modifying Hong in this manner. First, the discussion of faster access in Hong is based on storing a record of a server that is open to a user: "since the user's server would be identified in the first stage of the first phase and access would be almost instantaneous" (p. 10, ¶ 3). Identifying a server that is closed to a user during the first stage of the method in Hong would not provide access at all, and would still require the client 1 to search for addresses having open ports. Furthermore, Hong repeatedly describes storing records only for successful responses or hosts, *i.e.* ones found to have open ports, and not for those that are unsuccessful, *i.e.* ones found to be closed. As such, Hong teaches away from the modification suggested by the Office. Such a "teaching away" precludes a finding of obviousness, and to ignore the teaching away is clearly prohibited. *See* MPEP 2141.02 ("A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.")

Accordingly, claims 2 and 28 are allowable under the provisions of 35 U.S.C. § 103(a). Claims 4-11 and 24-26, which depend from claim 2, are also allowable. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 21 is amended herein into independent form to include the limitations previously recited in claim 1. Claim 31 is amended herein into independent form to include the limitations previously recited in claim 27. Claim 21 recites the limitations of "concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer" and

"attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name and the password." Claim 31 recites the limitation of "a host name generator for concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer."

The Office acknowledges that Hong does not teach "adding mail, pop, pop3 to the domain name," but takes "Official Notice" that it is well known in the art to use these as prefixes for a mail server domain name. (Office Action, p. 6) Applicants respectfully submit that it is not common knowledge or well known in the art to concatenate a prefix with an electronic mail account domain to form a default name for a server as recited in the context of claims 21 and 31, e.g., in the context of determining information needed to access an electronic mail account based on an address for the electronic mail account.

Accordingly, Applicants submit that claims 21 and 31 are allowable under the provisions of 35 U.S.C. § 103(a). Claims 22 and 23, which depend from claim 21, are also allowable. If the Office maintains the present rejection, Applicants demand specific evidence be provided to support the Examiner's statement of official notice.

The rejection of claims 13-20 and 32-34 are moot, as these claims have been cancelled without prejudice or disclaimer.

## ENTRY OF AMENDMENTS

The amendments to claims 2, 21, 24-26, 28 and 31 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

## CONCLUSION

Claims 2-11, 21-26, 28, 29, and 31 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

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